



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/815,254

03/31/2004

Ezra Jacques Elie Eric Setton

80398P595

7457

8791

7590

05/21/2008

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP  
1279 OAKMEAD PARKWAY  
SUNNYVALE, CA 94085-4040

EXAMINER

ABRAHAM, ESAW T

ART UNIT

PAPER NUMBER

2112

MAIL DATE

DELIVERY MODE

05/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/815,254	SETTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ESAW T. ABRAHAM	2112	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **Response to Applicant's argument/Amendment**

1. In view of the amendment filed on 02/13/08, The Examiner withdraws all objections to the claims.
2. Applicant's arguments, see Remark, filed 02/13/08, with respect to claims 1, 5, 8-11, 15, 18-21, 25, 28-31, 35 and 36 have been fully considered and are persuasive. The rejection under 103(a) has been withdrawn. However, the argument to overcome the 101 rejection to claims 21-30 is not convincing and the rejection is alive or maintained and further a new ground(s) of rejection is made under 35 USC 112, 2<sup>nd</sup> paragraph and under 35 USC 101 to claims 1-10 and 21-36.

### **DETAILED ACTION**

3. Claims **1-36** remain pending.

#### ***Claim Rejections - 35 USC § 112 (new)***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 8 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

The preamble in claims 1, 8 and 31 recite "An apparatus". The limitations in claims 1, 8 and 31 recite the following structural elements belonging to the apparatus: a

Art Unit: 2112

buffer, a selector and an analyzer (as in claim 1), an input/output module, a feedback generator, a decoder (as in claim 8), and means for storing, means for selecting and means for analyzing (as in claim 31).

For example, the applicant disclosure paragraph 023 teaches “The transmitter 120 is a module located at a content delivery server to transmit the media content 110 to the receiver 140. The transmitter 120 **may be a software module**, a hardware circuit, or a combination of both hardware and software.

NOTE: The examiner would like to point out that the Apparatus in claims 1 and 31 refers to the transmitter having the components of claims 1 and 31 such as buffer or means for storing, selector or means for selecting and analyzer or means for analyzing of figure 2 and further the apparatus (transmitter), in the disclosure described as the apparatus (transmitter) could be a software module. Therefore, the structural cooperation of claims 1 and 31 is not clear since Electronic form and source are not components of an apparatus.

Further, the applicant disclosure paragraph 025 teaches “the receiver 140 is a module located at a client to receive the media content stream. The receiver 140 **may be a software module**, a hardware circuit, or a combination of both hardware and software”

NOTE: The examiner would like to point out that the Apparatus in claim 8 refers to the receiver having the components of claim 8 such as an input/output module, a feedback generator, a decoder of figure 3 and further the apparatus (receiver), in the

disclosure described as the apparatus (receiver) could be a software module.

Therefore, the structural cooperation of claims 1 and 31 is not clear since Electronic form and source are not components of an apparatus.

Claims 2-7, 9, 10 and 32-34 depend from claims 1, 8 and 31 and therefore are also rejected for the same reasons as cited for claims 1, 8 and 31.

***Claim Rejections - 35 USC § 101 (New)***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10 and 31-34 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

Although claims 1, 8 and 31 are nominally drawn to an "apparatus" for reasons related to discussion of claims 11 and 18 (see the rejection of claims 11 and 18 below), the apparatus of claims 1, 8 and 31 do not apply its abstract idea to produce a useful, concrete, and tangible result.

The "buffer or means for storing, selector or means for selecting, analyzer or means for analyzing" of the of apparatus of claims 1 and 31 are depicted as boxes comprising "apparatus" or "transmitter" 120 in Figure 2. The applicant disclosure paragraph 023 teaches "The transmitter 120 is a module located at a content delivery server to transmit the media content 110 to the receiver 140. The transmitter 120 **may be a software module**, a hardware circuit, or a combination of both hardware and software. Instant claims 1 and 31 are not limited, however, to any tangible embodiment.

The "input/output module, a generator, and a decoder of the apparatus of claim 8 are depicted as boxes comprising "apparatus" or "receiver" 140 Figure 3. The applicant disclosure paragraph 025 teaches "the receiver 140 is a module located at a client to receive the media content stream. The receiver 140 **may be a software module**, a hardware circuit, or a combination of both hardware and software".

The claim may be read, under a broad but reasonable interpretation, as reciting transmitter or receiver in the disclosure, such as a software module that is not tied to a particular machine ---computer software per se or computer listing per se. *See Manual of Patent Examining Procedure* § 2106.01, heading I (8th ed., Rev. 6, Sept. 2007) ("USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.") and instant claims 1, 8 and 31 are not limited to a statutory class (e.g., machine or manufacture), and thus not directed to statutory subject matter. "The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007).

Therefore, thus claims 1, 8 and 31 are non-statutory as these claims are directed toward "software per se".

Claims 2-7, 9, 10 and 32-34 depend from claims 1, 8 and 31 and therefore are also rejected for the same reasons as cited for claims 1, 8 and 31.

6. Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Instant claims 11 and 18 recite a "method" each claim comprising three steps. The claims, if statutory, falls within the statutory class of "process." "A process is... an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing." *Cochrane v. Deener*, 94 U.S. 780, 788 (1877). "Transformation and reduction of an article "to a different state or thing" is the clue to the patentability of a process claim that does not include particular machines." *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)).

There are cases suggesting that the lack of transformation is not determinative with respect to whether a claimed process is statutory. Those cases, however, involved inventions that at least used *machines* to transform *data*. For example, our reviewing court in *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1357 (Fed. Cir. 1999), set forth (citing *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994) (en banc)) that a § 101 inquiry is directed to the determination of whether the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been reduced to some practical application rendering it "useful." A claimed process that produces a useful, concrete, tangible result without pre-empting other uses of the mathematical principle falls within the scope of § 101. *AT&T Corp.* at 1358. The process

held to be statutory in *AT&T Corp.*, however, required the use of switches and computers. See, e.g., *id.* at 1358 (AT&T's claimed process used "switching and recording mechanisms" to create a "signal" useful for billing purposes).

The "process" of instant claims 11 and 18 does not require any transformation and reduction of an article "to a different state or thing." Nor is the "process" tied to a particular machine that transforms data in such a way to produce a useful, concrete, and tangible result. Under a broad but reasonable interpretation of claims 8 and 18, the subject matter of the claim requires at most human thought and paperwork. Claims 8 and 18 do not recite any particular way of implementing the steps. Claims 8 and 18 do not require any machine or apparatus to perform the steps. Claims 8 and 18 do not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Claims 11 and 18 do not call for any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals. Claim 7 represents mere abstraction; i.e., a disembodied mathematical concept representing nothing more than an "abstract idea," which has not been reduced to some practical application that renders it "useful." As the Supreme Court has made clear, "[a]n idea of itself is not patentable." *In re Warmerdam*, 33 F.3d 1354, 1360 (quoting *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507, 22 L.Ed. 410 (1874)).

Claims 12-17, 19 and 20 depend from claims 11 and 18 and therefore are also rejected for the same reasons as cited for claims 11 and 18.

Art Unit: 2112

7. Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For example the Applicant's disclosure, paragraph [0074] teaches "The processor readable or accessible medium" or "machine readable or accessible medium" may include any medium that can store, transmit, or transfer information. Examples of the processor readable or machine accessible medium include an electronic circuit, a semiconductor memory device, a read only memory (ROM), a flash memory, an erasable ROM (EROM), a floppy diskette, a compact disk (CD) ROM, an optical disk, a hard disk, a fiber optic medium, a radio frequency (RF) link, etc. The computer data signal may include any signal that can propagate over a transmission medium such as electronic network channels, optical fibers, air, electromagnetic, RF links, etc. The code segments may be downloaded via computer networks such as the internet, Intranet, etc. The machine accessible medium may be embodied in an article of manufacture.

As such, the claims are not limited to statutory subject matter since the medium can be a software, hardware or firmware and are therefore non-statutory. Additionally, the claims lack accomplishing a practical application such as producing a useful, concrete tangible result.

Claims 22-27, 29 and 30 depend from claims 21 and 28 and therefore are also rejected for the same reasons as cited for claims 21 and 28.

## **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esaw T. Abraham whose telephone number is (571) 272-3812. The examiner can normally be reached on M-F 8am-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EA

/Esaw T Abraham/

Examiner, Art Unit 2112

05/15/08